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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,170	01/22/2004	Bahar N. Wadia	37041-11007	7836
2574	7590	11/16/2004	EXAMINER	
JENNER & BLOCK, LLP ONE IBM PLAZA CHICAGO, IL 60611			TRUONG, BAO Q	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/764,170	WADIA ET AL.	
	Examiner	Art Unit	
	Bao Q. Truong	2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 January 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-55 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-55 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 22 January 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20 September 2004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "a user interface panel" of claims 5 and 33, the "a sensor" of claims 24 and 51, the "a first electrode" of claims 25 and 52, the "a second electrode" of claims 26 and 53, the "an active component" of claims 27 and 54, and the "an integrated control circuit" of claims 28 and 55 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 1 and 29 are objected to because of the following informalities: "a substrate" in line 2 should be changed to –said substrate-- as it refers to "a substrate" in line 1. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-9, 17-22, 29-37 and 45-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen [US 5,226,723].

Regarding claims 1 and 29, Chen discloses a display having a substrate [2] with a first surface and a second surface, a penetration through the substrate [2] with a side wall [21], an entrance opening, an exit opening, and a light source [3] (figure 1).

Regarding claims 2 and 30, Chen discloses said substrate [2] being uniform thickness (figure 1).

Regarding claims 3 and 31, Chen discloses said substrate [2] being of varying cross-section (figure 1).

Regarding claims 4 and 32, Chen discloses a printed wring board [1] (figure 1).

Regarding claims 5 and 33, Chen discloses a user interface panel [22] (figure 1).

Regarding claims 6-9 and 34-37, Chen discloses a reflective side wall coating [21] (figures 1-2).

Regarding claims 17-20 and 45-48, Chen discloses LED [3] (figure 2).

Regarding claims 21 and 49, Chen discloses a single element defined by a single aperture (figures 1-2).

Regarding claims 22 and 50, Chen discloses a plurality of elements defined by a plurality of apertures (figures 1-2).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10-16 and 38-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Telefonbau [DE 1099403].

Regarding claims 10-12 and 38-40, Chen does not disclose the light guide within the penetration.

Telefonbau teaches a light guide [5] within a penetration (figure 4).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the penetration of Chen with the light guide as taught by

Telefonbau to transmit light for purpose of providing a combined solid structure with a substrate to prevent breakable.

Regarding claims 13-14 and 41-42, Chen discloses the substrate [2] being substantially imperious to light transmission (figures 1-2).

Regarding claims 15 and 43, Telefonbau discloses a light diffuser [2] (figure 4).

Regarding claims 16 and 44, Telefonbau discloses a layer of light transmissive [12] (figure 4).

7. Claims 23-28 and 51-55 are rejected under 35 U.S.C. 103(a) as being obvious over Chen in view of Caldwell [US 5,594,222].

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer

in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Regarding claims 23-28 and 51-55, Chen does not disclose the sensor mounted on the substrate, the first and second electrodes disposed on the substrate, the active component and the integrated control circuit.

Caldwell discloses a touch sensor including electrodes, an active component and an integrated control circuit (abstract, figures 1-14).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the substrate of Chen with the touch sensor including two electrodes, the active component and the integrated control circuit as taught by Caldwell for purpose of providing an advantageous way of detecting user contact of an opposite side of a substrate.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mouyard et al. [US 4,254,453] discloses LEDs array with a diffuse lens; Koike et al. [US 6,345,903] discloses a glass epoxy resin in LED; Morley et al. [US 6,809,470] discloses the use of OLED and PLED.

Art Unit: 2875

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bao Q. Truong whose telephone number is (571) 272-2383. The examiner can normally be reached on Monday-Friday (8:00 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bao Q. Truong
Examiner
Art Unit 2875

Thom M. Semb
Thomas M. Semb

Primary Examiner